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REMARKS

Claims 1-54, and 56-65 were previously canceled. Claims 55, and 66-88 were previously presented. Accordingly, claims 55, and 66-88 are pending examination.

Interrelationship between pending rejections

This pending Office Action contains both obviousness rejections under 35USC§103 and also double patenting rejections. If the Applicant has successfully overcome the obviousness rejections then there is most likely no need to even consider the double patenting rejections for the reasons set forth in MPEP §804 as applied in the following paragraphs. Under these circumstances, when the Applicant overcomes the obviousness rejections, there are no issues remaining for appeal and the application should be allowed to issue.

The double patenting rejection is made in view of U.S. Patent Application serial number 10/665,687 which has not issued, is co-owned, and has the same inventive entity. Under these circumstances, the double patenting rejection is a provisional double patenting rejection as set forth in chart I-B of MPEP §804 and also in the first paragraph of MPEP §804(I)(B).

When the Applicant overcomes the obviousness rejections, then the provisional double patenting rejection is the only pending rejection in the application and the first or second paragraph of MPEP §804(I)(B)(1) applies. The first paragraph indicates that the current applications should be allowed if a double patenting rejection is not the only pending rejection in the 10/665,687 application and the current Application is the earlier filed application. The first paragraph indicates that the current applications should be allowed if a double patenting rejection is the only pending rejection in the 10/665,687 application and the current Application is the “base” application. As a result, if these conditions are satisfied, the merits of the double-patenting rejection need not be considered and the current application should be allowed.

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Rejection of Claim 55 Under 35 USC §103

Claims 55 stands rejected under 35 USC §103(e) as being unpatentable over U.S. Patent Application No. 2002/0001745 A1 (Gartstein) in view of U.S. Patent No. 4,638,555 (MacLachlan). However, making the modification suggested in the Office Action does not result in the claimed invention.

Claim 55 recites the “pin extending through the first end cap and electrically insulated from the case.”

The Office Action cites Figure 3 of MacLachlan and argues that:

It would have been obvious to one of ordinary skill in the art to extend the terminal pin through the end cap of Gartstein, as taught by MacLachlan.

However, Gartstein’s paragraph 57 provides that “the entire top cap 16 is conductive and forms the positive terminal 20 of the battery 10.” As a result, extending the pin through Gartstein’s end cap as suggested by the Office Action does not result in the pin being electrically insulated from the case as recited in claim 55. Accordingly, the cited art does not teach or suggest every element of claim 55 and the rejection should be withdrawn.

Double patenting rejection

All of the pending claims stand rejected for double patenting in view of U.S. Patent Application serial number 10/665,687 (the ‘687 application). For the purposes of establishing a record for Appeal, the Applicant hereby repeats all of the previously asserted arguments with respect to this rejection. The Applicant also offers the following comments in response to the arguments presented in the Office Action.

The prohibition against double patenting rejections of previously restricted claims applies to this rejection.

In response to the Applicant’s argument that the prohibition against this double patenting rejection applies, the Office Action now claims that previous Restriction Requirement is withdrawn. This withdrawal appears to be an attempt

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to effectuate the provisions of MPEP §804.01(E). However, MPEP §804.01(E) provides the following:

(T)he prohibition *>against< double patenting rejections under 35 U.S.C. 121 does not apply: (when the) ... requirement for restriction was withdrawn by the examiner before the patent issues (emphasis added).

The requirement for restriction was not withdrawn before the patent issued. The patent application in which the Restriction Requirement was mailed issued on December 30, 2003 as patent number 6,670,071. However, the Restriction Requirement at issue was essentially repeated in this application as recently as November 30, 2006. As a result, the Restriction Requirement was not withdrawn before the patent issued, and MPEP §804.01(E) does not apply. Since the provisions of MPEP §804.01(E) still apply, the prohibition against the double patenting rejection remains intact.

The Rejection Remains Improperly Based on Claim Domination

The Office Action states that Applicants remarks on claim domination are not persuasive because the application 10/665,687 (the '687 application) anticipates the claims of the present invention. However, anticipation of the pending claims by the '687 application does not provide any insight into the pending rejection. The basis for a double patenting rejection is a comparison of the claims in this application against the claims of the '687 application (MPEP §804). However, MPEP §804 provides the following caveat:

(t)his does not mean that one is precluded from all use of the patent disclosure. ... The specification can be used as a dictionary to learn the meaning of a term in the patent claim.

As a result, the Examiner can use the specification as a dictionary but cannot use the specification as the basis for the double patenting rejection. Since support for the current double patenting rejection is essentially limited to the claims of the '687 application and the only claim-based argument asserted in support of the double patenting rejection is based on domination, the domination argument is

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essentially the only pending argument in support of this rejection. However, since MPEP §804 provides that "domination by itself ... cannot support a double patenting rejection," the double patenting rejection relies on improper reasoning and should be withdrawn.

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CONCLUSION

The Examiner is encouraged to telephone or e-mail the undersigned with any questions.



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